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05/13/1999

ROGER YOUMAN

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ROPES & GRAY LLP

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EXAMINER

USTARIS, JOSEPH G

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/313,532
Filing Date: May 13, 1999
Appellant(s): YOUMAN ET AL.

Pristine Johannessen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 1, 2009 appealing from the Office action mailed December 10, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,629,733

Youman et al.

5-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24-27, 29-43, and 45-55 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Regarding claims 24 and 40, in the parent application 08/346,603, applicant surrendered a broad claim 1 in view of an amended version in amendment 'A', dated March 11, 1996. Amendment 'A' specifically presents a claim which included the limitation "...wherein said video display generator display said *n* characters and said selection means comprises means for causing said character displays to cycle forward and backward through a plurality of alphanumeric characters and means for assigning one of said alphanumeric characters to each of said *n* characters."

On page 14 of the amendment 'A', applicant specifically argues, "Furthermore, even if the teachings of Reed are applied to either Young or Vogel, because Reed does not disclose how to select multiple characters in a title using only a remote control device, one of ordinary skill in the art would still not be possessed of the invention described and claimed by applicants. For example, parent application 08/346,603, claim 1 has been amended to recite i) that a plurality of characters in the title are input by the user, and ii) the specific means by which this is done – *'providing a user selection means to cycle forward and backward through a plurality of alphanumeric characters'* in order to locate each of the desired characters in the title."

At least the argued limitation of *"cycle forward and backward through a plurality of alphanumeric characters"* in claim 1 of the parent application 08/346,603 appears to be absent from the reissue application claims 24 and 40. There doesn't appear to be a broader version of this argued limitation on the reissue application claims 24 and 40 in order to avoid recapture under Ex parte Eggert, see MPEP 1412.02.

(10) Response to Argument

Introduction

Appellant argues with respect to claims 24 and 40, on page 11 of the brief, that the requirements for a 35 U.S.C. 251 rejection for improper recapture of broadened claimed subject matter have not been met. However, the examiner respectfully disagrees. As stated in the rejection, parent application 08/346,603 (Now Patent 5,629,733), claim 1 has been amended to recite i) that a plurality of characters in the title are input by the user, and ii) the specific means by which this is done – *'providing a*

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user selection means to cycle forward and backward through a plurality of alphanumeric characters' in order to locate each of the desired characters in the title.

At least the argued limitation of "*cycle forward and backward through a plurality of alphanumeric characters*" in claim 1 of the parent application 08/346,603 (Now Patent 5,629,733) appears to be absent from the reissue application claims 24 and 40. There doesn't appear to be a broader version of this argued limitation on the reissue application claims 24 and 40 in order to avoid recapture under Ex parte Eggert, see MPEP 1412.02.

Three Step Test for Recapture

The Three Step Test for Recapture states:

1. first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
2. next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
3. finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid recapture rule.

Limitations of Claim 1 of Patent 5,629,733 that are omitted from the reissue

- A. "selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title, where n is greater than one" (lines 16-18);

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B. “wherein said video display generator.....said selection means” (lines 23-24;

C. “means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters” (lines 24-27);
and

D. “means for assigning one of said alphanumeric characters to each of said n characters. (lines 27-29)”

Application of the Three Step Test for Recapture

Step 1:

It is found that limitations A, B, C, and D stated above were omitted from the reissue. Therefore, the reissue claims are broader in scope than the original patent claims.

Step 2:

It is found that limitations B and C stated above that are omitted from the reissue are related to subject matter surrendered in the original prosecution. The limitation of *“providing a user selection means to cycle forward and backward through a plurality of alphanumeric characters”* was argued in the parent application to make the application allowable over the cited art in the parent application (See Amendment A in 08/346,603 filed on 3/11/1996).

Step 3:

It is noted that appellants are incorrect that the reissue claims are narrower in an aspect germane to the prior art rejection because the limitations of *“a wireless remote*

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control, nonalphanumeric keys, and changing from a first character to a second character using the nonalphanumeric keys” were not amended or argued in the original prosecution to overcome an art rejection.

Furthermore, appellant contends that the “*display generator*” and “*data processor*” are not related to the prior art rejection because appellant did not argue these limitations. While it is true that the appellant did not argue the “*display generator*” and “*data processor*” in the originally filed application, the more important point is that those limitations are not the subject matter that were added and argued in the parent application that created the surrendered generating limitation (SGL). In other words, the SGL is items B and C described above.

This SGL is completely omitted from the reissue claims 24 and 40. In particular claims 24 and 40 do not recite the following:

- A. “wherein said video display generator.....said selection means”
- B. “means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters”; and
- C. means for assigning one of said alphanumeric characters to each of said n characters.

Therefore, after applying recapture steps 1-3, it is determined that the reissue claims fail to avoid the recapture rule.

Conclusion

Since the omitted limitations B and C stated above were argued in the original application to make the application claims allowable over the art in the application, then

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the omitted limitations B and C relates to subject matter previously surrendered in the original application, and recapture will exist.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joseph G. Ustaris

/Joseph G Ustaris/

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